

### **REMARKS**

This responds to the Office Action mailed on December 17, 2008.

No claims are amended, canceled, or added; as a result, claims 1, 2, 4-10, 12-18, 20-25 and 27-31 remain pending in this application.

#### **§103 Rejection of the Claims**

Claims 1-2, 4-10, 12-18, 20-25, and 27-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zeller (U.S. Publication No. 2004/0111431, hereinafter "Zeller") in view of Stern (U.S. Publication No. 2002/0032740, hereinafter "Stern").

#### **The Applicable Law**

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; MPEP § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; MPEP § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR*

*Int'l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_ (2007)(slip opinion at 14)(citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

The court in *Fine* stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so."

*Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

MPEP § 2142.

The test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *KSR Int'l*

Co., 550 U.S. \_\_\_\_ (2007)(slip opinion at 12)(citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966)).

Further, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. See *KSR Int'l Co.*, 550 U.S. \_\_\_\_ (2007)(slip opinion at 14)(citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)); *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Finally, the Examiner must avoid hindsight. *In re Bond* at 834.

Additionally, there must be a rational underpinning grounded in evidence to support the legal conclusion of obviousness. See *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006), which states that, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn* citing *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). Additionally, "mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole." *In re Kahn*.

#### The Obviousness Rejection

Claims 1-2, 4-10, 12-18, 20-25, and 27-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zeller (U.S. Publication No. 2004/0111431, hereinafter "Zeller") in view of Stern (U.S. Publication No. 2002/0032740, hereinafter "Stern").

Zeller describes a method of displaying a common manager view within an organization. The method requires that organization information stored in a database be read. *Zeller at [0031]*. The organization data includes the name of each individual in the organization, the name of their manager and a profile. *Zeller at [0032]*. A user selects two individuals in the organization and the method generates a view showing the manager chain of the two individuals traced up in the organization to a common manager. *Zeller at [0037-0038]*.

Stern describes a computer automated method and system for mining, from the Internet, information about people and organizations. Stern does describe combining information on an organization (*Stern at [0134]*) or an individual (*Stern at [0155]*) extracted from different web pages, but the information is not used to construct an organizational hierarchy. As noted at

[0155-156], data from different web pages is combined into a single data set associated with an individual if the name in each web page is the same and both web pages show the individual worked for the same company. That is, if a first page includes an individual's name, company and work address and a second page includes the individual's name, company and work phone number, Stern combines the information to form a single record for the individual listing the individual's name, company, work address and work phone number.

As noted above, there must be a rational underpinning grounded in evidence to support the legal conclusion of obviousness. See *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006), which states that, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn* citing *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). Additionally, "mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole." *In re Kahn*.

The Examiner stated that the mining method of Stern could be used within the manager display method of Zeller to form a hierarchy of employees from two different data sources. Applicant respectfully submits that, at most, the combination of Stern with Zeller teaches a way to take a record from Zeller's database and combine that record with one or more records extracted from web pages. Neither reference teaches **"linking employees as a function of the organization information to form a hierarchy of employees, wherein linking includes mapping information from each of the plurality of disparate data sources to categories and storing the mapping as an info set, wherein at least one category present in the first data source is not present in the second data source"** as taught by Applicant and required by claims 1 and 2. Similarly, neither reference teaches **"determining an organization hierarchy from the extracted organization information, wherein determining organization hierarchy includes linking employees as a function of the organization information to form a hierarchy of employees and locating the user within the hierarchy of employees, wherein linking includes mapping information from each of the independent organization information data sources to first categories and storing the mapping in an info set, wherein at least one category present in the first data source is not present in the second data source"** as taught by Applicant and required by claims 12-18 and 27-29.

The Examiner failed to address, however, each element of claims 12-18 and 27-29 in his rejection. For instance, there is no mention in any of the cited references of

**“extracting data from one or more third data sources, wherein extracting includes mapping information from each of the third data sources to second categories, wherein at least one of the second categories is different from categories in the first categories; or of generating a report, wherein the report includes data extracted from the one or more third data sources, wherein generating a report includes filtering the report as a function of the user’s location in the organization hierarchy”**

as described by Applicant and claimed in claims 12-18 and 27-29. Since elements of claims 12-18 and 27-29 are missing from both references, claims 12-18 and 27-29 cannot be obvious in view of the combination of references. Reconsideration and allowance is respectfully requested.

Neither reference teaches **“a plurality of disparate data sources, including a first data source and a second data source, wherein each data source includes categories of organization information about people within the organization and wherein at least one category present in the first data source is not present in the second data source”** as taught by Applicant and required by claim 21. Similarly, none of the references teach generating a report as a function of the user’s place within the organization as required by claim 21.

Finally, neither reference teaches **“determining an organization hierarchy from the extracted organization information, wherein determining organization hierarchy includes linking employees as a function of the organization information to form a hierarchy of employees and locating the users within the hierarchy of employees, wherein linking includes mapping information from each of the independent organization information data sources to first categories and storing the mapping in an info set, wherein at least one category present in the first data source is not present in the second data source”** as taught by Applicant and required by claims 22, 25, 30 and 31. There is no discussion of linking, or of an info set, or of a number of other claim elements in either of the cited references. At the same time, there is no mention of generating reports in the cited references as required by claims 22, 25, 30 and 31. Reconsideration and issuance of a Notice of Allowance is respectfully requested.

The Examiner rejected claim 13, stating that Zeller discloses

The Examiner also stated that Zeller teaches (at [0054]) filtering each user's report as a function of threshold information and the user's place in the hierarchy. Applicant is also unable to see this teaching in any of the cited references. Clarification is requested.

In his rejection of claims 29 and 31, the Examiner stated that Zeller discloses "wherein one of the first categories is a conditions on notification category associated with each user and wherein generating includes delivering a report as a function of information in the conditions on notification associates with each user (See paragraph 0047)." Paragraph 47 of Zeller, however, describes no such thing. There are no "conditions of notification" as required by claims 29 and 31 and there is no delivering of the report as a function of information in the conditions of notification taught by Applicant and claimed in claims 29 and 31.

Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 1, 2, 4-10, 12-18, 20-25 and 27-31.

**CONCLUSION**

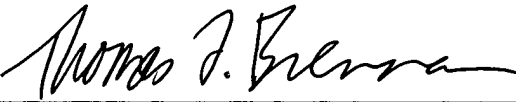
Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 373-6909 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

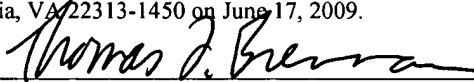
SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6909

Date June 17, 2009

By   
Thomas F. Brennan  
Reg. No. 35,075

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 17, 2009.

Thomas F. Brennan  
Name

  
Signature